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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/601,040

06/20/2003

Wayne Jacob Gregoire

7169

7590

05/23/2006

Wayne J. Gregoire  
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EXAMINER

SELF, SHELLEY M

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/601,040	GREGOIRE, WAYNE JACOB	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shelley Self	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,11,13,14,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 and 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,11,13,14,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/27/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on February 28, 2006 has been considered but fails to place the application in condition for allowance and an action on the merits follows.

### ***Election/Restrictions***

Newly submitted claims 16-20 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 16-20 and 23-27 are drawn to separable and distinct species of spacers, not originally presented.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-20 and 23-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Furthermore, Examiner notes that claim 16 was withdrawn from consideration in the previous Office Action pursuant to Applicant's election without traverse of the restriction requirement filed July 7, 2005.

### ***Drawings***

The Examiner approves the replacement drawings filed December 27, 2006.

### ***Information Disclosure Statement***

The information disclosure statement filed December 27, 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because copies of the Non-Patent Literature references were not included. It has been placed in the application file, but the information

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referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

For full consideration of the IDS, Examiner suggests, Applicant submit copies of the relevant pages of Shaper Handbook listed on the IDS.

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Abstract is objected to for the use of the term, "***comprising***" line 1. The Abstract should be clear, concise and narrative in form, the term "***comprising***" is legal phraseology usually used in the claims and should be avoided in the Abstract. Accordingly, appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Neither the specification nor the drawings provide support and clear definition of functionality of a space of either preset length or adjustable length.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 4, 13, 14, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 4 (line 18, 19) and claim 21 (line 22), there is no antecedent basis for the recitation, "the woodworking machine", it is unclear if the wood working machine is the same as the woodworking tool or if the two are different components/elements; if different, how does the woodworking machine relate to the woodworking tool? Clarification is required.

Additionally regarding claim 4, lines 19-20, the recitation, "such as a cutting portion..." renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Appropriate correction is required.

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Further regarding claim 4, lines 18-19, the phrase, “the horizontal member is positioned a distance from a desired part of the woodworking machine...” renders the claim vague and indefinite. It is unclear what is meant by, “a desired part of the woodworking machine”, such appears to be relative and does not clearly define any structure, i.e. desired by what? Whom? Clarification is required.

With regard to claim 21, line 12 there is no antecedent basis for the recitation, “the connection”; it is not clear what is meant by “the connection”, i.e., the connection of what? What is being connected? Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 4 as best as can be understood and as noted in the previous Office Action is rejected under 35 U.S.C. 102(e) as being anticipated by Jukoff et al. (6,619,347). Jukoff discloses an adjustable back fence for workpiece milling on woodworking tools chosen from the group consisting of a wood shaper, a router table and a table saw, the adjustable back fence comprising: an indexing channel system (fig. 1) including at least one channel (44,46) having an elongated slot (50,52), the channel having a channel stop (Examiner notes that the end of the channel serves as a stop, i.e., the channel ends, is stopped) at one end of the elongated slot (fig.

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1), the channel being adjustably attachable (42) to the woodworking tool (12) so that the channel is movable on and secured to the woodworking tool in a desired configuration; at least one spacer (64) that fits within and is retained in the slot (50, 52); and a horizontal member (58) attachable to the indexing system through at least one adjustable connection (66, 72), the connection having a connection member (66) extending into the elongated slot (52) of the channel (46), the connection member interacting with the elongated slot to secure the horizontal member (58) to the channel (col. 6, lines 55-60) in a space relationship from the channel stop, the spaced relationship determined by the length of the spacer; whereby once the indexing channel system is secured to the woodworking tool, the horizontal member is positioned a distance from a desired part of the woodworking tool (fig. 1).

With regard to claim 11, as best as can be understood, Jukoff discloses a bracket (105) interlocking the adjustable back fence to a fence system (fig. 1).

With regard to claim 14, as best as can be understood, Jukoff discloses the spacer (64) having a predetermined length.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 21 and 22 as best as can be understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Jukoff et al. (6,619,347). With regard to claim 13, the claim is a

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product-by-process claim; further the process, i.e. extrusion by which the channel is formed is not germane to the patentability of the claimed invention and does not result in any patentably distinct end product than another process.

As to the shaped of the slot being eight an upright or inverted T, it would have been obvious at the time of the invention to one having ordinary skill in the art to construct the slot of any shape, since such shape has not defined to solve a particular problem or create any unobvious result. Further *In re Dailey*, 357 F.2d 669 , 149 USPQ 47 (CCPA 1966) The court held that configuration of a claimed element is a matter of obvious design expedient requiring only routine skill in the art and would be found obvious absent any persuasive evidence that the particular configuration/shape of the claimed invention is significant.

As to the indexing channel system, at least one channel, an elongated slot, a connection, a spacer and horizontal member see above with regard to claim 4.

With regard to claim 22, see above with regard to claim 11.

### ***Response to Arguments***

Applicant's arguments have been carefully considered but are moot in view of the new ground(s) of rejection.

Applicant's remarks are drawn to the failure of the prior art, Jukoff to disclose "at least one spacer" to hold a horizontal member " a distance from a desired part of the woodworking machine". This argument is not found persuasive, because as noted above, Jukoff disclose at least one spacer (64) wherein the spacer in conjunction with the indexing system and channel (46) hold the horizontal member (58) at a distance from a desired part of the woodworking



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machine (10) as the entire indexing system (44, 46) movable relative to the table (12) of the woodworking machine (10). Accordingly the claimed invention fails to patentably define over the prior art of record.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

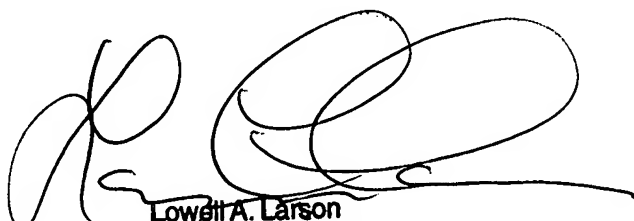
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

May 1, 2006



Lowell A. Larson  
Primary Examiner



REPLACEMENT SHEET

1/17

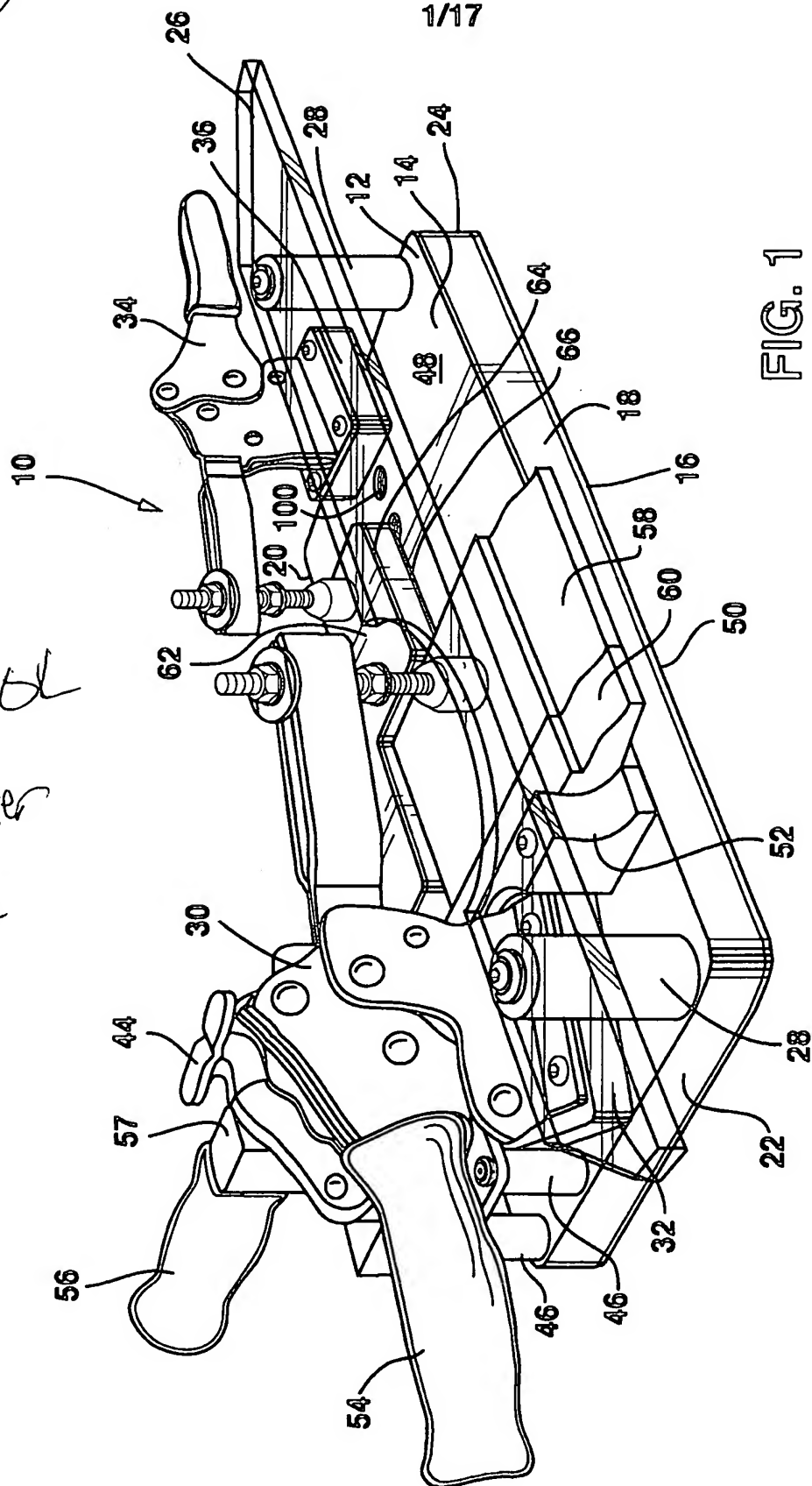


FIG. 1

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